

Remarks:

Claims 18-35 are pending in the application. Claim 26 (indicated to be directed to allowable subject matter) is rewritten in independent form; claim 35 is amended to clarify what “it” is referring to in one instance; and claim 36 is newly presented. Applicant requests reconsideration and allowance in view of the following remarks.

Rejections Under 35 U.S.C. § 112

Claim 35 is rejected under 35 U.S.C. § 112, first paragraph. According to the Examiner, while the claim specifies that the second blank is substantially flat in that it lacks a cavity but otherwise matches the contour of an upper, joining surface of the first blank, the upper blank is shown in Figure 2 as having a recess/cavity and therefore it is not substantially flat. Applicant traverses that rejection. The term “cavity” is referring to what may be called a hole or a hollow, which denotes the concept of a space that is bounded on, at the very least, all but one side. Such a hole or hollow is not what is shown in the second blank in Figure 2. Rather, as recited in the claim, the blank follows or matches the undulating contours of the mating surface of the flange on the first blank as that flange dips and rises. Thus, Applicants submit that the claim is, in fact, supported by what is shown in Figure 2 and therefore request that the rejection be withdrawn.

Claim 35 is also rejected under 35 U.S.C. § 112, second paragraph, on the basis that the term “it” on line 12 is unclear. Applicant has changed “it” to “said second blank” to make clearer that to which “it” refers back. Accordingly, Applicants request that the rejection be withdrawn.

Rejection Under 35 U.S.C. § 103

Claims 18-25 and 28-35 are rejected under 35 U.S.C. § 103(a) based on Schneider et al., U.S. 2,674,783, in view of Lee et al., U.S. 5,934,544. The Examiner relies on Schneider for the claim-recited heating, press-forging, and working of the first blank steps, as well as the claim-recited placing and joining steps. The Examiner acknowledges that Schneider does not disclose

the claim-recited step of roll-forming step (“directing the first blank (1) between a pair of rollers (3,4) . . . ” However, according to the Examiner, Lee discloses “directing a first blank (18) between a pair of rollers (102, 104)[.]” Therefore, according to the Examiner, “it would have been obvious . . . to direct a first blank of Schneider between a pair of rollers having profiled surfaces, in light of the teachings of Lee, in order to form the blank into a vehicular structural member having the desired shape.” Applicants traverse this rejection for several reasons.

First, Applicants note that the Examiner’s analysis apparently overlooks the fact that none of the documents describe forming a pair of blanks having the same hat profile. Thus, the Examiner has not established a *prima facie* case of obviousness for that reason.

Second, Lee does not disclose roll-forming a first blank as asserted by the Examiner, which implies that other blanks are also formed in some fashion in Lee. Rather, all Lee discloses is forming a blank by roll-forming.

Third, and most significant, Schneider discloses one complete process that relies on die-forging of the parts, whereas Lee discloses another complete process that relies on roll-forging of a single part. The claimed method, in contrast, requires both a roll-forming step and a die-forging step to shape the first blank. The issue, then, is why it would have been obvious to add a further, roll-forging step (as per Lee) into the complete, self-sufficient or stand-alone die-forging process of Schneider, and the Examiner’s explanation as to why the claimed combination would have been obvious (“in order to form the blank into a vehicular structural member having the desired shape”) fails to address or explain that issue. In fact, the Examiner’s explanation, which really says nothing more than it would have been obvious to use roll-forming to obtain a desired shape, ultimately does not say anything meaningful at all.

Thus, the Examiner has failed to establish a *prima facie* case of obviousness. Accordingly, Applicants traverse the rejection and request that it be withdrawn.

New Claim 36

New claim 36 is similar to claim 18 but specifies that the second blank is formed by steps that are the same as those used to form the first blank. Applicants submit that that concept is not shown in either of the applied references.

Allowable Subject Matter

Claims 26 (depending from claim 18) and 27 (depending from claim 26) are objected to as depending from a rejected base claim but are otherwise indicated to be directed to allowable subject matter. Claim 26 has been rewritten into independent format. Accordingly, claims 26 and 27 should now be allowable. In view of the foregoing, however, Applicants submit that all claims are in condition for allowance, and timely Notice to that effect is respectfully requested.

The undersigned representative requests any extension of time that may be deemed necessary to further the prosecution of this application.

The undersigned representative authorizes the Commissioner to charge any additional fees under 37 C.F.R. 1.16 or 1.17 that may be required, or credit any overpayment, to Deposit Account No. 14-1437, referencing Attorney Docket No.: 0173.038.PCUS01.

In order to facilitate the resolution of any issues or questions presented by this paper, the Examiner may directly contact the undersigned by phone to further the discussion.

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Respectfully submitted,

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